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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,231	10/29/2003	Merlin Stover	P06457US00	5252
22885	7590	11/24/2004	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			KOYAMA, KUMIKO C	
		ART UNIT	PAPER NUMBER	
			2876	

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<i>Supplemental Office Action Summary</i>	Application No.	Applicant(s)
	10/696,231	STOVER, MERLIN
	Examiner	Art Unit
	Kumiko C. Koyama	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 August 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 August 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **SUPPLEMENTAL DETAILED ACTION**

Acknowledgement is made of receipt of Amendment filed on August 16, 2001.

As indicated on PTO-413, during the interview, Applicant Mr. Stover and Applicant's representative Mr. Egolf have pointed out the difference between the prior art (Martin) and the claimed invention. Upon careful review of the prior art and the claimed invention as well as the Final Office Action mailed on November 2, 2004, the Examiners believe that the Applicants have misunderstood Examiner's use of the prior art applied to the rejections. Therefore, in order to clarify such misunderstanding, the Examiner provides herein a Supplemental Office Action including a further explanation of the Examiner's position by providing detailed comments with respect to the Declaration filed under 37 CFR 1.131 and Examiner's interpretation/use of Martin.

**This is a Supplemental Final Office Action. This supplemental office action SUPERSEDES the previous Final Office Action mailed on November 2, 2004.**

### ***Claim Objections***

1. Claim 6 is objected to because of the following informalities:

Re claim 6: There appears to be a typographical error on line 2 of claim 6. "x;" should be deleted.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkinson (US 5,863,074) in view of Martin (US 6,390,362).

Wilkinson discloses a fraud inhibiting personal check, which is a bank check, as shown in Fig. 1. Wilkinson discloses that a merchant receives, or accepts, a personal check and conforms the identify of the person negotiating the check at the time of the transaction, wherein the personal check has identification indicia, such as a picture of the fact of the person and a predetermined signature of the person, pre-printed onto the check (col 3, lines 4-9; col 2, lines 36-48 and Fig. 1). Wilkinson also teaches method of comparing signature of the check writer with a signature displayed (col 1, lines 45-46) and a method of comparing the person depicted on the check and the person cashing the check (col 6, lines 5-7).

Although Wilkinson teaches a pre-printed identification indicia, such as a picture of a person, predetermined signature, bank ID number, account numbers, address, etc., that provides personal information about the writer, Wilkinson does not teach that such identification indicia is in a bar code form and driving as well as reading such bar code for comparison reasons.

Martin teaches a negotiable instrument including a machine readable code, the machine readable code containing the drawer's account number, the drawee's routing number and one or more pieces of information from the group consisting of the following: a payee, the amount of

negotiable instrument, a date, the identify of the drawer, a memo, and an identifier number of the negotiable instrument (col 4, lines 65+). These information are considered as personal identification information. Martin also discloses means for scanning the information on the negotiable instrument and means for comparing the information from the machine-readable code to the information on the negotiable instrument (col 6, lines 5-10).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Martin to the teachings of Wilkinson because barcodes can store a lot of information with utilization of little space on the negotiable instrument, and therefore, enhances fraud protection by storing more information about the user. Furthermore, utilizing a bar code for identification purposes would provide an accurate reading because the bar code is read by a machine, and therefore, an accurate identification of the user is achieved.

4. Claims 2, 3 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkinson as modified by Martin as applied to claim 1 above, and further in view of Iguchi et al (US Patent Application No. 2002/0071682). The teachings of Wilkinson as modified by Martin have been discussed above.

Re claim 1, 3, 7 and 8: Wilkinson as modified by Martin fails to teach that the personal information from the bar code comprises a home address and telephone number.

Iguchi teaches a barcode containing customer information, such as address and telephone number (Page 8, Paragraph [0145]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Iguchi to the teachings of Wilkinson as

modified by Martin in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

Re claim 9: Wilkinson discloses that the picture input is received through preloaded memory such as a disk or from a photograph whose image is input through a scanner connected to the personal computer (col 5, lines 19-23). Such disclosure teaches that the photograph is in a digital format.

Re claim 10: Wilkinson discloses that the signature input can be input from a prewritten embodiment read though a scanner connected to the personal computer, or the signature can be input through a writing input means by which the personal computer can directly receive a written signature (col 5, lines 25-31). Such disclosure teaches that the signature is in a digital format.

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkinson as modified by Martin and Iguchi as applied to claim 3 above, and further in view of Houvener (US 5,657,389). The teachings of Wilkinson/Martin/Iguchi have been discussed above.

Wilkinson/Martin/Iguchi fail to teach that the personal identification information from the bar code further comprises a digital photograph of the writer and a digital image of the writer's signature.

Houvener teaches that a database retrieval system where the database includes digital photographic image, signature or other unique data to individuals for positive identity verification purposes and a bar code system for retrieving the database information (col 4, lines 18-21 and col 5, lines 15-20).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Houvener to the teachings of Wilkinson/Martin/Iguchi in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Iguchi.

Pearson shows a bank check 1 without any personal information, such as home address and telephone number, visible as shown in Fig. 1 and Fig. 2. Pearson also shows a black bar 3, which includes indicia that identifies account number, routing number and check number (col 1, lines 44+).

However, Pearson fails to teach a pre-printed bar code having a home address and telephone number.

Iguchi teaches a barcode containing customer information, such as address and telephone number (Page 8, Paragraph [0145]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Iguchi to the teachings of Pearson in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Iguchi as applied to claim 12 above, and further in view of Houvener. The teachings of Pearson as modified by Iguchi have been discussed above.

Pearson as modified by Iguchi fails to teach that the pre-printed bar code further comprises a digital photograph of the writer and a digital image of the writer's signature.

Houvener teaches that a database retrieval system where the database includes digital photographic image, signature or other unique data to individuals for positive identity verification purposes and a bar code system for retrieving the database information (col 4, lines 18-21 and col 5, lines 15-20).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Houvener to the teachings of Pearson as modified by Iguchi in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Iguchi as applied to claim 12 above, and further in view Perttunen et al (US 5,939,699). The teachings of Pearson as modified by Iguchi have been discussed above.

Pearson as modified by Iguchi fail to teach the pre-printed bar code comprises a social security number of the writer.

Perttunen teaches a prestored code that includes a social security number (col 4, lines 30-36). The prestored code is a bar code (col 4, lines 37-38).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Perttunen to the teachings of Pearson as modified by Iguchi because social security number is a combination of numbers uniquely assigned to one person that is commonly used to link the person and his/her financial

information. Such modification enhances the security of the check by uniquely identifying the person cashing the check.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Regarding claim 1, Applicant changed the claim from "accepting a negotiable instrument from a writer" to "accepting a negotiable instrument having a pre-printed bar code from a writer." Such amended claim changes the scope of the claim because the current amended claim now recites that only the pre-printed bar code from a writer and is no longer related to the photo identification and the pre-printed signature.

Applicant amended claims 6 and 12 from "a check without any personal information visible" and "a negotiable instrument" to specifically reciting "a bank check." Since the newly added limitation (i.e. a bank check) is a new issue which was not considered in previous action and such new limitations required further search and consideration, this office action is made Final.

With respect to Applicant's submission of the Declaration filed under 37 CFR 1.131, the Examiner does not find the declaration to be persuasive in order for the application to be allowed. The filed Declaration merely shows the importance of the Applicant's invention. However, the Declaration does not show that the instant invention was invented prior to the effective date of the reference/prior art. The Examiner also believes that the pre-printed bar code

is taught by Wilkinson in view of Martin as described in the above rejection. Therefore, the instant application remains rejected as set forth in this office action.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 571-272-2394. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Kumiko C. Koyama*  
Kumiko C. Koyama  
November 18, 2004

*Diane I. Lee*  
DIANE I. LEE  
PRIMARY EXAMINER